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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,215	01/19/2001	Bernard Agasse	11345.019001	3920

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EXAMINER

DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,215

Applicant(s)

AGASSE, BERNARD

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 3, Reference Number 52. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Figure 6, Reference Number 67. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 4 is objected to because of the following informalities: "plurality" is misspelled on Page 27, Line 20. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 7, 15-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,585,866 to Miller et al. as disclosed by Applicant.

Regarding Claim 1, Miller discloses a digital television system comprising a decoder (See Figure 1), characterized in that the decoder is adapted to display a service menu (See Figure 6A). Miller discloses that the system receives a transmitted data stream such as a standard television broadcast, cablecast or satellite transmission (Col. 7, Lines 48-63). As is well understood in the art, television broadcasts contain a plurality of channels (Col. 13, Lines 16-20). Further, Miller discloses services such as pay-per-view (Col. 18, Lines 26-48), information services and games (Col. 28, Lines 62-67), which comprise service channels that may be real channels (Col. 29, Lines 18-19). Miller further discloses access to at least one of a plurality of channels proceeding via at least one subsidiary menu (See Figure 18) accessed by the service menu (See Figure 6, 61A).

Regarding Claim 2, Miller discloses a system as stated above in Claim 1 in which a user is further able to utilize a category menu (See Figure 19) from within the EPG screen (See Figure 18) to narrow down and select programming. Further, a user may select a pay-per-view program from the EPG resulting in a subsidiary menu being displayed, which asks the user to choose a time and to confirm ordering of the programming before viewing (Col. 18, Lines 26-60). Both of these sub-menus for selecting programs read on the claimed second subsidiary menu accessible via the at least one first subsidiary menu for accessing one of a plurality of channels.

Regarding Claim 3, Miller discloses a system as stated above in Claim 1 wherein pay-per-view programming is provided on a service channel as stated above. This reads on the claimed decoder being adapted to access a service channel at a particular display screen (start of a movie) within that service channel in dependence on the option chosen within a subsidiary menu as stated above.

Regarding Claim 7, Miller discloses a system as stated above in Claim 1 further comprising a remote control handset associated with the decoder (See Figures 3 and 4), the decoder being adapted to display the service menu in response to the touch of a single dedicated key on the handset (47B and Col. 5, Lines 15-20).

Regarding Claims 15-17, see Claims 1-3 above, respectively.

Regarding Claim 21, see Claim 7 above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5, 8-13, 18-19 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. in view of U.S. Patent No. 5,828,420 to Marshall et al.

Regarding Claim 4, Miller discloses a system as stated above in Claim 1. What is not disclosed, however, is that the decoder is adapted to display the service menu and at least one subsidiary menu superimposed over information transmitted on the at least one

of a plurality of channels. Marshall discloses an electronic program guide wherein the menus are superimposed over the information transmitted on a video channel (See Abstract and Figures 3-9). Marshall is evidence that ordinary workers in the art would recognize the benefits of overlaying an EPG on video programming in a digital television system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Miller with the EPG overlaid on the video programming of Marshall in order to allow a user to continue to view programming when they are navigating through the EPG menus.

Regarding Claim 5, Miller in view of Marshall disclose a system as stated above in Claim 4. Miller further discloses a service menu (EPG) that provides a list of current and future programming to the user (See Figure 18). Miller further discloses updating the stored information on a periodic basis (Col. 8, Lines 27-30). The program schedule information is broadcast with the television programming (Cols. 7-8, Lines 64-9). This reads on the claimed at least one service menu (EPG screen) further comprising regularly updated information broadcast together with the channel information over which the menus are superimposed.

Regarding Claim 8, Miller discloses a digital television system comprising a decoder for receiving a plurality of channels as stated above. Miller further discloses a transmission means for transmitting a plurality of television channels (Col. 7, Lines 61-63). Miller also discloses transmitting audiovisual information regarding programs or services available on at least some of the other channels (Col. 8, Lines 27-30) and that the data may be transmitted by embedding it in the VBI of a program broadcast signal (Col.

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8, Lines 7-9). This reads on the claimed one channel being used to carry the information. What is not disclosed, however, is that the decoder is adapted to generate and display interactive messages superimposed over and synchronized with the information regarding at least some of the other channels. Marshall discloses an electronic program guide wherein the menus are superimposed over the information transmitted on a video channel (See Abstract and Figures 3-9). It is inherent that the overlay be synchronized with the video programming in order to properly display the combined video data coherently. Marshall is evidence that ordinary workers in the art would recognize the benefits of overlaying an EPG on video programming in a digital television system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Miller with the EPG overlaid on the video programming of Marshall in order to allow a user to continue to view programming when they are navigating through the EPG menus.

As stated above, the EPG screen may be superimposed on top of the video programming. This reads on the claimed decoder being adapted to generate and display interactive messages superimposed over and synchronized with the information regarding at least some of the other channels (television programming).

Regarding Claim 9, Miller in view of Marshall disclose a system as stated above in Claim 8. Miller further discloses that the user may browse through the interactive menu and depress a button to instruct the tuner to tune to a channel (Col. 13, Lines 55-61). This reads on the claimed decoder being adapted to change to another channel in

response to a positive reply by a user (pressing the Enter key) to an interactive message (EPG display).

Regarding Claim 10, Miller in view of Marshall disclose a system as stated above in Claim 8. Miller further discloses a menu icon that allows the user to be connected to a programming service such as pay-per-view (Col. 18, Lines 61-67). Miller also discloses that the service may be an information service or game as stated above. This reads on the claimed decoder being adapted to change to a predetermined display screen of a service channel in response to a positive reply to an interactive message.

Regarding Claim 11, Miller in view of Marshall disclose a system as stated above in Claim 8. Miller further discloses that a user may order premium services (See Figures 9 and 22-24) by entering a purchase code (See Figures 40B-40E). This reads on the claimed decoder being adapted to carry out payment steps in response to a positive reply by a user to an interactive message.

Regarding Claim 12, Miller in view of Marshall disclose a system as stated above in Claim 8. Miller further discloses a decoder adapted to tune to a channel guide and display a service menu (See Figure 18) providing access to the channels and service channels received by the decoder. Since the channel guide is fixed in place until the user makes a selection, it reads on the claimed permanent display.

Regarding Claim 13, Miller in view of Marshall disclose a system as stated above in Claim 12. What is not disclosed, however, is that the decoder is adapted to display the service menu in an inactive form. Official Notice is hereby taken that it is well known in the art of user interfaces to make a menu inactive when a prompt or other action takes

precedence. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Miller in view of Marshall with the inactive menu of the well-known prior art in order to force a user to make a selection from an interactive prompt or message when one is displayed.

Regarding Claims 18-19, see Claims 4-5 above, respectively.

Regarding Claims 22-27, see Claims 8-13 above, respectively.

8. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. in view of Marshall et al. and further in view of U.S. Patent No. 6,115,074 to Ozkan et al.

Regarding Claim 6, Miller in view of Marshall discloses a system as stated above in Claim 5. What is not disclosed, however, is transmission means adapted to broadcast update information for said at least one service menu on substantially all channels and service channels. Ozkan discloses a digital television system using the MPEG standard for transmission of channel map and program table information (See Abstract) wherein ancillary program specific information includes data for a program guide (Col. 1, Lines 52-56 and Col. 3, Lines 30-40). Each transport stream comprises data packets containing the channel data itself and program specific information (Col. 3, Lines 53-55). This reads on the claimed broadcasting update information for at least one service menu (EPG) on substantially all channels and service channels. Ozkan is evidence that ordinary workers in the art would recognize the benefits of using a well-known standard such as MPEG to transmit program-specific data such as EPG data along with each transport stream. Therefore, it would have been obvious to one having ordinary skill in the art at the time

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the invention was made to modify the system of Miller in view of Marshall with the MPEG transport streams of Ozkan in order to utilize a well-known and supported industry standard to reduce costs and increase compatibility of the system.

Regarding Claim 20, see Claim 6 above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 5,539,479 to Bertram discloses a television receiver with tiered menu interface and various interactive applications accessible through the interface.

b. U.S. Patent No. 6,704,028 to Wugofski discloses a television system with multi-level interactive menus for program selection through an EPG.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mrd

July 21, 2004



CHRIS GRANT
PRIMARY EXAMINER